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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,673	06/27/2003	Chul Chung	17209-340	8308
54205 7590 05/27/2010 CHADBOURNE & PARKE LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER GREENE, DANIEL LAWSON	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 05/27/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/608,673	<b>Applicant(s)</b> CHUNG, CHUL	
	<b>Examiner</b> DANIEL L. GREENE JR.	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The communication received 2/5/2010 has been considered and entered. Claims 1-16 are pending, with claims 1 and 8-11 being amended in said communication. Claims 4-7 were previously withdrawn. An action on the merits of claims 1-3 and 8-16 follows.

### ***Response to Arguments***

2. Applicant's arguments and amendments to claims 1, 8 and 11, see pages 2, 5, 6 and 10, filed 2/5/2010, with respect to the 35 USC 101 and 112 rejections set forth in sections 7 and 8 of said previous Office action have been fully considered and are persuasive. Accordingly, said rejections are hereby withdrawn.

**3. Applicant's arguments with regard to the 35 USC 102 rejection set forth in section 9 of said previous Office action have been fully considered but they are not persuasive.**

#### **Applicant argues on page 12:**

"...These portions of May just describe static screens or static interfaces that help users in entering order data or setting predefined preferences. These portions shows a clear lack of receiving a template corresponding to a particular type of trade, as the user must enter the order details in a static screen, providing no discussion of a template. Further, these static data entry screens were created as part of a database and never received. May just discusses data entry, where receipt of any data does not adapt the static screen for a reference entity or a reference obligation. Therefore, May does not teach or suggest "receive[ing] a template. May does not teach or suggest "receive[ing] a template for screening..." or "screen[ing] said received data..." let alone to "receive a template for screening said received data identifying said at least a first reference obligation...screen said received data according to the received template identifying said reference entity for accuracy" as recited in claims i and 8. "

#### **Response:**

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The Examiner has cited particular columns and line numbers in the references as applied to the claim(s) as nearly as practicable. Although the specified citations are representative of the teachings in the art as applied to the specific limitations within the individual claim(s), other passages and figures may apply as well. See MPEP 2260 [R-5], and 37 CFR 1.104(c)(2)

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

May clearly discloses “receiving templates” in, for example, Figures 9A, 9B, 10, 14A, 20, 22A, etc.

May clearly discloses “screening received data within said templates for accuracy” in, for example, Col. 39, lines 36-40, i.e. before pressing the Apply button (381). Further, Figure 26, step (526) provides for verifying the trade eligibility of the respective first and second users, which inherently includes screening for accuracy because if the user has inaccurately filled out the proper information then they will not be matched up and would therefore be ineligible to participate in the transaction.

Another way to look at the limitation "screening for accuracy" may be found within the input mechanisms themselves, e.g. Figure 14A requires a price and a quantity. If either of these is missing or inaccurate, the system/process cannot continue because improper parameters have been entered. That is, the templates themselves are screening for accurate data to be entered into the appropriate fields at the time of entry.

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Again, applicant's claims do NOT require any specific or precise order of implementation, they merely require the operations to be performed AT SOME POINT IN TIME.

May clearly discloses "receiving a template for screening said received data identifying said at least a first reference obligation" in, for example, Figure 14A wherein figure 14A is the template itself that was received and it does screen data it receives. For support, see AT LEAST Col. 34 line 60- Col. 35, line 17 reproduced immediately below.

**"The system checks any new order for reasonableness (or training) as they are placed.** For example, a bid cannot be higher than the existing offer without the user double checking. The tab key, enter key, or the mouse can be used to navigate through the passive order interface 294. Upon selecting the OK button, the order is submitted into the system 10 and the user is returned to the market entry interface 250.

(212) In specific regard to the HIT and LIFT buttons in the function bar 290, a user can initiate active orders by hitting a bid (i.e., sell) or lifting an ask (i.e., buy). By selecting either the HIT or LIFT button, a hit order window or a lift order window is presented to the user. For example, a hit order window 296 is illustrated in FIG. 14B. The hit order window 296 is substantially identical to the lift order window. As shown, the hit order window 296 identifies the instrument and order price. Further, the user is presented with a transaction quantity which is initially set for the full amount being offered by the counterparty. The user is allowed to reduce the quantity figure. **The user is not allowed at this point to increase the quantity figure because the counterparty has already indicated the quantity they are desiring to sell.** Upon selecting the OK button, the order is executed by the system in the manner described below, and the user is returned to the market entry interface 250. " (Emphasis added)

The Examiner construes the teaching of **"The user is not allowed at this point to increase the quantity figure because the counterparty has already indicated the**

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**quantity they are desiring to sell.** “ as requiring the form to be screened for accuracy in that the system prevents users from increasing the quantity figure.

May also clearly disclose “screening said received data according to the received template identifying said reference entity for accuracy” in the above citations wherein all templates must inherently include identifying information for the reference entity when they are submitted otherwise the system would not know who sent the template to the system.

**4. Applicant’s arguments with regard to the 35 USC 103 rejection set forth in section 10 of said previous Office action have been fully considered but they are not persuasive.**

**Applicant argues:**

“Applicant submits May or Clark, alone or in combination, do not discuss or render obvious at least the following element(s) as recited, inter alia, in independent claim 1:  
receive a template for screening said received data identifying said at least a first reference obligation...screen said received data according to the received template identifying said reference entity for accuracy”

**Response:**

See the discussion set forth in section 3 above.

Further, resort may be had to the following case law citations to show the knowledge level of one of ordinary skill in the art.

**In re Nilssen** (CA FC) 7 USPQ2d 1500 (7/13/1988)

“Specifically, Nilssen asserts that "it would be in manifest conflict with reality to assume that such a person would be familiar with all prior art references pertaining to [a] given art... **The board attributes to the "hypothetical person" knowledge of all prior art in the field of the inventor's endeavor and of prior art solutions for a common problem even if outside that field. That view accords**

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with the plethora of this court's precedent. See, e.g., *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 USPQ 293, 297 (Fed. Cir. 1985); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). “ (Emphasis added)

*In re Bozek*, 163 USPQ 545 (CCPA 1969)

“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”

Katz et al. Col. 1 lines 25-45 (portion reproduced immediately below) clearly supports the Examiners contentions of what is old and well known in the art of verifying financial transactions.

“For example, even merchants having the most liberal policy of cashing checks still request some form of identification, as a driver's license or credit card from an unknown person.” (Emphasis added)

Applicant should be well apprised that it is well known in the OTC art for information to be screened for accuracy as evidenced by applicants 10/2/2003 IDS, NPL B, Allen and Overy, “An introduction to the Documentation of OTC derivatives: “Ten Themes””, Page 7, last paragraph (reproduced immediately below) it is known to check (screen) letters (templates) for accuracy (completed correctly).

ISDA facilitates this amendment process by receiving Adherence Letters from market participants, checking that the letters have been completed correctly, and, on its website, displaying the letters it has received together with a list of those market participants that have signed up to the Protocol (“Adhering Parties”). The list of Adhering Parties enables Adhering Parties to ascertain with whom they have amended their contracts.

### *Claim Rejections - 35 USC § 102*

5. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent 6,317,727 B1 to May for the reasons set forth in section 7 of the previous

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**office action mailed 2/4/2009 which in turn refers back to section 8 of the previous office action mailed 7/8/2008.**

See the discussion of this topic in section 3 above.

***Claim Rejections - 35 USC § 103***

**6. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over May as applied to claims 1-3 and 8-16 above and further in view of U.S Patent 5,890,140 to Clark et al. for the reasons set forth in section 8 of the previous office action mailed 2/4/2009.**

See the discussion of this topic in section 4 above.

***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE JR. whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./  
Examiner, Art Unit 3694  
2010-05-22

/Ella Colbert/  
Primary Examiner, Art Unit 3694